



Attorney's Docket No. 006701.P002XC4

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Julian N. Nikolchev, *et al.*

Examiner: Henry A. Bennett

Application No.: 10/600,298

Art Unit: 3743

Filed: June 20, 2003

For: CONTRACEPTIVE TRANSCERVICAL
FALLOPIAN TUBE OCCLUSION
DEVICES AND METHODS

Mail Stop AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

INFORMATION DISCLOSURE STATEMENT

Enclosed is a copy of Information Disclosure Citation Form PTO/SB/08 together with copies of the documents cited on that form, except for copies not required to be submitted (e.g., copies of U.S. patents and U.S. published patent applications need not be enclosed for applications filed after June 30, 2003). It is respectfully requested that the cited documents be considered and that the enclosed Information Disclosure Citation Form be initialed by the Examiner to indicate such consideration and a copy thereof returned to Applicants.

Included in this IDS are documents from a patent litigation between Conceptus (Assignee of the present application) and Ovion (original Assignee of the Callister patents that Applicants are currently seeking an interference with). Many of these documents have also been submitted in Ovion's 08/770,123 application (now U.S. Patent No. 7,073,504) and its continuations. Applicants also submit herewith copies of the

dockets from the litigation, which list the documents filed with the Court during the proceedings. If the Examiner would like copies of any additional documents from the docket, Applicants would be happy to provide them.

Pursuant to 37 C.F.R. § 1.97, the submission of this Information Disclosure Statement is not to be construed as a representation that a search has been made and is not to be construed as an admission that the information cited in this statement is material to patentability.

Pursuant to 37 C.F.R. § 1.97, this Information Disclosure Statement is being submitted under one of the following (as indicated by an "X" to the left of the appropriate paragraph):

☐ 37 C.F.R. § 1.97(b).

☒ 37 C.F.R. § 1.97(c). If so, then enclosed with this Information Disclosure Statement is one of the following:

☐ A statement pursuant to 37 C.F.R. § 1.97

☒ A check for \$180.00 for the fee under 37 C.F.R. § 1.17(p).

☐ 37 C.F.R. § 1.97(d). If so, then enclosed with this Information Disclosure

Statement are the following:

(1) A statement pursuant to 37 C.F.R. § 1.97(e); and

(2) A check for \$180.00 for the fee under 37 C.F.R. § 1.17(p) for

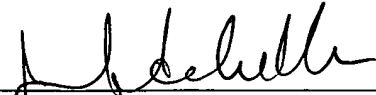
submission of the Information Disclosure Statement.

Please charge any shortages and credit any overcharges to our Deposit Account
No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 11/20, 2006


James C. Scheller, Jr.
Reg. No. 31,195

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026
(408) 720-8300

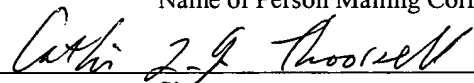
FIRST CLASS CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on: November 20, 2006.


Date of Deposit

Cathi L.G. Thoorsell

Name of Person Mailing Correspondence


Signature

November 20, 2006
Date

Substitute for Form 1449/PTO					Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(use as many sheets as necessary)</i>			Application Number		10/600,298	
			Filing Date		June 20, 2003	
			First Named Inventor:		Julian N. Nikolchev	
			Art Unit		3743	
			Examiner Name		Henry A. Bennett	
Sheet	1.	of	3	Attorney Docket No.		006701.P002XC4

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published	T ²
	1.	Conceptus, Inc.'s <u>Complaint for Declaratory Judgment of Patent Non-Infringement, Invalidity and Unenforceability; and Demand for Jury Trial</u> , Case #:3:02-cv-1968), filed in U.S. District Court Northern District of California, San Francisco Division, executed April 22, 2002, pages 1-10.	
	2.	Conceptus, Inc.'s <u>Conceptus, Inc.'s Patent Local Rule 4-2 Preliminary Claim Constructions and Extrinsic Evidence, with Proof of Service</u> Case No. C-02-1968 (MHP), filed in U.S. District Court Northern District of California, San Francisco Division, executed June 19, 2003, pages 1-16.	
	3.	Conceptus, Inc.'s <u>Conceptus' Amended Answer to Ovion's Complaint, Affirmative Defenses and Counterclaims, and Jury Demand</u> , Case No. C-02-3884 (MHP), filed in U.S. District Court Northern District of California, executed September 26, 2002, pages 1-12; Proof of Service, pages 1-2.	
	4.	Conceptus, Inc.'s <u>Conceptus' Answer to Ovion's Complaint, Affirmative Defenses and Counterclaims</u> , Case No. C-02-3884 (MHP), filed in U.S. District Court Northern District of California, executed September 25, 2002, pages 1-12.	
	5.	Conceptus, Inc.'s <u>Conceptus' Motion For Summary Judgment of Invalidity of the Asserted '116 Patent Claims in view of Conceptus, Inc.'s '979 Patent</u> Case No. C-02-1968 (MHP), filed in U.S. District Court Northern District of California, executed October 6, 2003, pages i-v and 1-25.	
	6.	Conceptus, Inc.'s <u>Declaration of Dr. Ralph M. Richart in Support of Conceptus, Inc.'s Motion for Summary Judgment of Invalidity of the Asserted '116 Patent Claims in View of Conceptus, Inc.'s '979 Patent</u> , Case No. C-02-1968 (MHP), filed in U.S. District Court Northern District of California, San Francisco Division, executed October 6, 2003, pages 1-	

Examiner Signature	Date Considered
--------------------	-----------------

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹Applicant's unique citation designation number (optional). ²See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴For Japanese patent documents, the indication of the year of reign of the Emperor must precede the serial number of the patent document. ⁵Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶Applicant is to place a check mark here if English language translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SENT FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

Substitute for Form 1449/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(use as many sheets as necessary)</i>			Complete if Known		
			Application Number	10/600,298	
			Filing Date	June 20, 2003	
			First Named Inventor:	Julian N. Nikolchev	
			Art Unit	3743	
			Examiner Name	Henry A. Bennett	
Sheet	2.	of	3	Attorney Docket No.	006701.P002XC4

		14, Exhibits 1-5.	
--	--	-------------------	--

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published	T ²
	7.	Conceptus, Inc.'s <u>First Amended Complaint For (1) Declaration Judgment of Patent Non-Infringement, Invalidity and Unenforceability; (2) False Advertising Under 15 U.S.C. § 1125(A); (3) Trade Libel; (4) Unfair Competition Under Common Law and Cal. B&P §17200 Et Seq.; (5) Unjust Enrichment; and (6) Constructive Trust Demand for Jury Trial</u> , Case #:3:02-cv-1968 MHP, filed in U.S. District Court Northern District of California, executed June 13, 2001, pages 1-19.	
	8.	Conceptus, Inc.'s <u>Preliminary Invalidity Contentions</u> , Case #:3:02-cv-1968 MHP and Case No. C-02-3884 (MHP), filed in U.S. District Court Northern District of California San Francisco Division, executed April 20, 2003, pages 1-129; Certificate of Service, pages 1-3.	
	9.	KERIN, J.F., "New Methods for Transcervical Cannulation of the Fallopian Tube," <u>International Journal of Gynecology and Obstetrics</u> , 51 Suppl. 1 (1995) pages S29-S39.	
	10.	Ovion, Inc.'s and Conceptus, Inc.'s, <u>Joint Claim Construction and Prehearing Statement Pursuant to Patent Local Rule 4-3</u> , Case No. C-02-3884 (MHP), filed in U.S. District Court Northern District of California, San Francisco Division, executed August 6, 2003, pages 1-5; Table 1, pages 1; Table 2, pages 1-67; Table 3, pages 1-6; and <u>Joint Claim Construction and Prehearing Statement Pursuant to Patent Local Rule 4-3</u> , with Expert Reports, tabs 1-4 as exhibits.	

Examiner Signature		Date Considered	
--------------------	--	-----------------	--

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹Applicant's unique citation designation number (optional). ²See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴For Japanese patent documents, the indication of the year of reign of the Emperor must precede the serial number of the patent document. ⁵Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶Applicant is to place a check mark here if English language translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SENT FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

Substitute for Form 1449/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(use as many sheets as necessary)</i>			Complete if Known		
			Application Number	10/600,298	
			Filing Date	June 20, 2003	
			First Named Inventor:	Julian N. Nikolchev	
			Art Unit	3743	
			Examiner Name	Henry A. Bennett	
Sheet	3.	of	3	Attorney Docket No.	006701.P002XC4

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published	T ²
	11.	Ovion, Inc.'s <u>Complaint for Patent Infringement; and Demand for Jury Trial</u> , Case No. C-02-3884, filed in U.S. District Court Northern District of California, executed August 13, 2002, pages 1-5.	
	12.	RISQUEZ, F., et al., "Transcervical Tubal Cannulation, Past, Present, and Future" <u>Fertility and Sterilization</u> , Centro Medico Docente La Trinidad, Caracas, Venezuela, and Mount Sinai Hospital Medical Center and Rush Medical College, Chicago, IL, Vol. 60, No. 2, August 1993 Pgs. 211-226.	
	13.	WILSON, E.W., "The Evolution and Methods for Female Sterilization", <u>International Journal of Gynecology & Obstetrics</u> 51 Suppl. 1 (1995) S2-S13.	
	14.	WILSON, E.W., "Sterilization" <u>Baillière's Clinical Obstetrics and Gynecology</u> , Vol. 10, No. 1, April 1996, pages 103-119.	
	15.	U.S. District Court California Northern District Civil Docket For Case #:3:02-cv-01968 MHP, pages 1-10.	
	16.	U.S. District Court California Northern District Civil Docket For Case #:3:02-cv-03884, pages 1-8.	

Examiner Signature		Date Considered	
--------------------	--	-----------------	--

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹Applicant's unique citation designation number (optional). ²See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴For Japanese patent documents, the indication of the year of reign of the Emperor must precede the serial number of the patent document. ⁵Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶Applicant is to place a check mark here if English language translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SENT FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.